Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)
Approved for use through 02/28/2009. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
200309561-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 01-07-2010

Signature /Nicole Solomon/

Typed or printed name Nicole Solomon

Application Number	Filed
10/803,225	3/16/2004

First Named Inventor: Zeying Ma

Art Unit	Examiner
2854	Marissa L. Ferguson Samreth

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 44266.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/garypoakeson/
Signature

Gary P. Oakeson
Typed or printed name

801-566-6633
Telephone number

01/06/2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REASONS FOR PRE-APPEAL BRIEF REVIEW

In the final Office Action of October 7, 2009 (hereinafter "Office Action"), claims 1, 3-4, 10-14, 16-17, 19-20, 22, and 26-27 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0168554 of Tsao (hereinafter "Tsao") in view of Japan Patent Application 2001-049155 of Iijima (hereinafter "Iijima") and U.S. Patent No. 6,585,366 to Nagata et al. (hereinafter "Nagata"). Additionally, claims 5-6, 15, 21, and 28-41 were each finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao, Iijima, and Nagata in combination with one or more additional references. In an Advisory Action issued January 5, 2010 (hereinafter "Advisory Action"), the Examiner maintained the above rejections for reasons of record.

In the following discussion, Applicants briefly present the arguments made regarding the final rejections listed above. In view of the following, Applicants submit that the rejections are improper because the at least one of the primary references cited (Tsao) is precluded under 35 U.S.C. § 103(c) from supporting a rejection under § 103(a).

The Claimed Invention

Reference is made to the previously filed response of May 26, 2009 (pages 10-11 and 13-14) as to the presently pending claim limitations. The present application was filed on March 16, 2004. It should be noted that for purposes of discussion, this filing date is used as the constructive date of invention of the claims at issue, in accordance with USPTO practice. This is not to be considered an averment by Applicants of the actual date of invention.

The Final Rejections under 103(a) based upon Tsao

In the Office Action, the Examiner based final rejections of all of the pending claims as being unpatentable over Tsao in combination with one or more secondary references. In the Response mailed December 1, 2009, Applicants pointed out that Tsao is precluded under § 103(c) from supporting a rejection of Applicants claims under § 103(a).

Under 35 U.S.C. § 103(c), subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102 shall not preclude patentability under § 103(a) when said subject matter was subject to common ownership at the time the claimed invention was made. 35 U.S.C. § 103(c)(1). Thus, a reference's subject matter must meet three criteria to be precluded under § 103(c): it must be developed by "another person;" it must only be prior art under subsections (e), (f), or (g) of § 102; and it must be subject to common ownership with the claimed invention when the invention was made. As Applicants have pointed out in the response and reiterate below, Tsao meets all three of these criteria.

1. Tsao Discloses Subject Matter Developed by Another

Applicants point out that the first criterion is met in this case, as Tsao discloses subject matter developed a person other than Applicants. The present claims and Tsao have no inventors in common. The inventors of the present claims are Zeying Ma and Gregg Lane, while Yi Hua Tsao is the sole inventor of the cited reference.

2. Tsao Does Not Qualify as Prior Art under Subsections Not Subject to 103(c)

Regarding the second criterion, Applicants have pointed out that Tsao, by virtue of its filing and subsequent publication date, does not qualify as prior art under the subsections of § 102 that are not subject to § 103(c). To be outside the reach of 103(c), a reference offered for what it teaches must qualify as prior art under § 102(a) or (b). As noted above, the claims at issue were filed on March 16, 2004. Tsao is a publication of a patent application filed on February 4, 2004 and published on August 4, 2005. As Tsao was not published before the filing date of the present invention, it does not meet the requirements of 35 U.S.C. § 102 (a) or (b).

In the Advisory Action, the Examiner has asserted that Tsao "does qualify as prior art under § 102(a) 'since it was known or used by others in this country…before the invention therof (*sic*) by the applicant for a patent.'" The Examiner asserts further that: "102(a) does not require that applications filed in this country be published before the filing date of the present claims."

Applicants submit that this reasoning constitutes an error by the Examiner. Under § 102(a),

> [a] person shall be entitled to a patent unless…the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent…*(emphasis added.)*

This subsection covers three types of prior art, listed in the alternative: knowledge or use by others, patented subject matter; and subject matter described in a printed publication (e.g. a published application).

The Examiner appears to be conflating the "known or used by others" provision with that referring to "printed publications," when in fact these refer to two different types of prior art. Applicants submit that this is an erroneous interpretation of the subsection, which presents these activities in the alternative. In view of the statutory language, the "known or used by others" provision clearly refers to activity other than the publication of patent applications, or the disclosure to a patent office by their inventor(s). Rather, it is directed to public use of invented subject matter. See, e.g. *Bayer AG v. Housey Pharms., Inc.,* 128 Fed. Appx. 767, 769 (Fed. Cir. 2005).

With regard to printed publications like Tsao, Applicants point out that MPEP 706.02(a).II.C clearly states: "For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work." (emphasis added). Therefore, a printed publication is prior art under § 102(a) as of its publication date. Tsao was not published before the filing date of the present invention, and therefore it does not meet the requirements of 35 U.S.C. § 102 (a). Rather, as a published application for a patent filed by another before the (constructive) date of invention, Tsao is *prima facie* qualified under § 102(e) only.

3. Tsao is Subject to Common Ownership with the Present Claims

The third criterion is clearly met in this case, and the Examiner has not disputed this. Tsao was and is still subject to assignment to Hewlett-Packard Development Company (Reel 015115, Frame 0930, executed January 12, 2004) The present claims are

also assigned to Hewlett-Packard Development Company (Reel 015122, Frame 0404, executed in March 2004).

In view of the above, Applicants submit that the Examiner has committed a clear error in failing to recognize that Tsao is disqualified under § 103(c) from supporting an obviousness rejection of the present claims. As such, Applicants submit that all rejections of the pending claims as obvious over Tsao should be reversed.

CONCLUSION

In view of the foregoing discussion, the obviousness rejections of the pending claims based on Tsao merit reversal and the claims should be allowed. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone Mr. Gary Oakeson at (801) 566-6633, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 7th day of January, 2010.

Respectfully submitted,

/garypoakeson/

Gary P. Oakeson
Registration No. 44266

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone: (801) 566-6633

On behalf of:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80528-9599